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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,272	05/25/2001	Shigeyuki Itoh	500.34063CX3	3510

20457 7590 04/07/2005

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EXAMINER	
ELMORE, JOHN E	
ART UNIT	**PAPER NUMBER**
2134	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/864,272	ITOH ET AL.	
	Examiner	Art Unit	
	John Elmore	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *29-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29,31-36,38-46,48-55 and 57-61* is/are rejected.

7)☒ Claim(s) *30,37,47 and 56* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 29-61 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/539,163, filed on October 4, 1995.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 29, 31-34, 36, 38-46, 48-51, 53-55 and 57-61 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Ushiki et al. (US 54,38,356), hereafter Ushiki, in view of Cheung (US 4,396,947).

Regarding claim 29, Ushiki discloses a device for charging a fee for information comprising

an input circuit (signal processing units 12) which inputs a main information signal (non-advertising multimedia information; col. 1, lines 13-20) and an auxiliary signal (advertising multimedia information; col. 1, lines 13-20);

a first charging information signal (charge rate stored in database unit 24; col. 3, lines 31-36), which indicates a first fee for reproducing said main information signal, and a second charging information signal, which indicates a second fee for reproducing said main information signal with said auxiliary information signal (fee computed using a discount rate; col. 5, lines 50-63; col. 8, lines 32-40), said second fee being different from said first fee;

a reproducing circuit which reproduces said main information signal and both said main information signal and said auxiliary information signal (multimedia information unit control 4 and multimedia information adding and distributing units 3; Fig. 2);

and a charge calculator (additional information accounting control unit 10 and call control unit 25) which calculates a fee when said main information signal is reproduced and calculates a different fee when both said main information signal and said auxiliary information signal are reproduced (discounted fee used when subscriber views advertising; col. 3, lines 31-36; col. 6, lines 58-64; col. 7, lines 4-8; col. 8, lines 27-40).

But Ushiki does not explain that the first charging information signal and the second charging information signal are received as inputs along with the main information signal and an auxiliary signal.

However, Cheung teaches a device for distributing video and charging a fee comprising input circuit which inputs, along with a main information signal, a charging information signal (encoded data signal containing billing data), which indicates a fee for reproducing the main information signal for the purpose of charging for video distribution

at a variable rate determined concurrently with transmission by the sender where the charge is metered by the receiver device (col. 4, lines 8-14; col. 6, lines 7-9; col. 6, line 60, through col. 7, line 5).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Ushiki with the teaching of Cheung to provide a system wherein the first charging information signal and the second charging information signal are received as inputs along with the main information signal and an auxiliary signal. One would be motivated to do so in order to charge for video distribution at a variable rate determined concurrently with transmission by the sender where the charge is metered by the receiver device.

Regarding claim 31, the modified device of Ushiki and Cheung is relied upon as applied to claim 29, and Ushiki and Cheung further teach

a detector which detects a reproducing amount of said auxiliary information signal (Ushiki, measurement unit 23),

wherein said charge calculator calculates a fee based on said second charging information signal and the reproducing amount of said auxiliary information signal (Ushiki, col. 3, lines 22-29; col. 8, lines 27-40).

But Ushiki and Cheung do not explicitly explain that said charge calculator calculates a fee based on said second charging information signal when the reproducing amount of said auxiliary information signal exceeds a predetermined amount.

However, the Examiner takes official notice that it would be obvious to one of ordinary skill in the art at the time the invention was made to calculate a fee based on said second charging information signal when the reproducing amount of said auxiliary information signal exceeds a predetermined amount. One would be motivated to do so where the fee resulting from a reproducing amount below a predetermined time would be impractical to collect (e.g. twenty cents on a credit card invoice).

Regarding claims 32 and 48, the modified device of Ushiki and Cheung is relied upon as applied to claims 29 and 43, respectively, and Ushiki and Cheung further teach

a detector which detects a reproducing time of said auxiliary information signal (Ushiki, measurement unit 23 and timer 5),

wherein said charge calculator calculates a fee based on said second charging information signal and the reproducing amount of said auxiliary information signal (Ushiki, col. 4, lines 11-18; col. 8, lines 27-40).

But Ushiki and Cheung do not explicitly explain that said charge calculator calculates a fee based on said second charging information signal when the reproducing amount of said auxiliary information signal exceeds a predetermined time.

However, the Examiner takes official notice that it would be obvious to one of ordinary skill in the art at the time the invention was made to calculate a fee based on said second charging information signal when the reproducing amount of said auxiliary information signal exceeds a predetermined time. One would be motivated to do so where the fee resulting from a reproducing amount below a predetermined time would be impractical to collect (e.g. twenty cents on a credit card invoice).

Regarding claims 33 and 50, the modified device of Ushiki and Cheung is relied upon as applied to claims 29 and 43, respectively, and Ushiki and Cheung further teach that said charge calculator calculates a fee based on an accumulation of the overall distribution of said second charging information signal (Cheung, col. 6, line 60, through col. 7, line 5).

But Ushiki as modified by Cheung, as applied to claim 29, does not explicitly explain that said first charging information signal is distributed in said main information signal and said second charging information signal is distributed in said auxiliary information signal.

However, Cheung teaches a device for distributing video and charging a fee wherein a charging information signal is distributed in a main information signal (col. 5, line 57, through col. 6, line 9) for the purpose of securing the information from unauthorized persons (Cheung, col. 1, lines 1-16).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the modified device of Ushiki and Cheung with the further teaching of Cheung such that said first charging information signal is distributed in said main information signal and said second charging information signal is distributed in said auxiliary information signal. One would be motivated to do so in order to secure the information from unauthorized persons.

Regarding claims 34 and 51, the modified device of Ushiki and Cheung is relied upon as applied to claims 29 and 43, respectively, and Ushiki and Cheung further teach a recording circuit which records said main information signal, said auxiliary information

signal, said first charging information signal and said second charging information signal on a medium (Ushiki, information storage units 21 and database units 7 and 24; Fig. 2; col. 3, lines 62-62; col. 4, lines 18-21).

Regarding claims 36, 38, 40, 42, 53-55 and 57-61, these are a system version of the claimed device discussed above (claims 29-33, 43-45, 47-50 and 29, respectively), wherein all claim limitations have been addressed. Thus, for the reasons provided above, such claims also would have been obvious.

Regarding claims 39, 41 and 49, the modified device of Ushiki and Cheung is relied upon as applied to claims 38, 40 and 43, respectively.

But Ushiki and Cheung do not explicitly explain that said first charging information indicates a first amount of charge per unitary time and said second charging information indicates a second amount of charge per unitary time.

However, the Examiner takes official notice that it would be obvious to one of ordinary skill in the art at the time the invention was made to calculate a fee based on said first charging information indicates a first amount of charge per unitary time and said second charging information indicates a second amount of charge per unitary time. One would be motivated to do so where the fee resulting from a charge per non-unitary time would be impractical to bill and collect (e.g. twenty cents on a credit card invoice).

Regarding claim 43, Ushiki discloses a device for charging a fee for information comprising

an input circuit (signal processing units 12) which inputs a main information signal (non-advertising multimedia information; col. 1, lines 13-20) and an auxiliary signal (advertising multimedia information; col. 1, lines 13-20);

a first charging information signal (charge rate stored in database unit 24; col. 3, lines 31-36), which indicates a first fee for reproducing said main information signal, and a second charging information signal, which indicates a second fee for reproducing said main information signal with said auxiliary information signal (discount rate; col. 5, lines 50-63; col. 8, lines 32-40);

a reproducing circuit which reproduces said main information signal and both said main information signal and said auxiliary information signal (multimedia information unit control 4 and multimedia information adding and distributing units 3; Fig. 2);

and a charge calculator (additional information accounting control unit 10 and call control unit 25) which calculates a fee when said main information signal is reproduced and calculates a second, different fee based on both said first charging information signal and said second charging information signal when both said main information signal and said auxiliary information signal are reproduced (discount rate applied to first fee when subscriber views advertising; col. 3, lines 31-36; col. 6, lines 58-64; col. 7, lines 4-8; col. 8, lines 27-40).

But Ushiki does not explain that the first charging information signal and the second charging information signal are received as inputs along with the main information signal and an auxiliary signal.

However, Cheung teaches a device for distributing video and charging a fee comprising input circuit which inputs, along with a main information signal, a charging information signal (encoded data signal containing billing data), which indicates a fee for reproducing the main information signal for the purpose of charging for video distribution at a variable rate determined concurrently with transmission by the sender where the charge is metered by the receiver device (col. 4, lines 8-14; col. 6, lines 7-9; col. 6, line 60, through col. 7, line 5).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Ushiki with the teaching of Cheung to provide a system wherein the first charging information signal and the second charging information signal are received as inputs along with the main information signal and an auxiliary signal. One would be motivated to do so in order to charge for video distribution at a variable rate determined concurrently with transmission by the sender where the charge is metered by the receiver device.

Regarding claim 44, the modified device of Ushiki and Cheung is relied upon as applied to claim 43, and Ushiki and Cheung further teach that said second charging information signal indicates discount rate for said first fee and said charge calculator calculates a fee based on both first and second charging information signals (Ushiki, col. 8, lines 27-40).

Regarding claim 45, the modified device of Ushiki and Cheung is relied upon as applied to claim 43, and Ushiki and Cheung further teach that said second charging information signal indicates a discount fee for said first fee, and said charge calculator

calculates a unique, said second fee by subtracting said discount fee from said first fee (Ushiki, col. 8, lines 27-40).

4. **Claims 35 and 52 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Ushiki and Cheung, as applied to claims 29 and 43, respectively, and further in view of Cohen et al. (US 5,282,249), hereafter Cohen.

Regarding claim 35, Ushiki and Cheung do not explain a charging process circuit which processes an IC card storing an electric money and a communication circuit which sends an electric money corresponding to a fee to a center.

However, Cohen teaches a system for video distribution comprising a charging process circuit which processes an IC card storing an electric money (col. 6, lines 38-41) and a communication circuit which sends an electric money corresponding to a fee to a center (col. 3, lines 24-48) for the purpose of improving the control of access to broadcast transmissions (col. 1, lines 29-31).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the modified device of Ushiki and Cheung with the teaching of Cohen to provide a charging process circuit which processes an IC card storing an electric money and a communication circuit which sends an electric money corresponding to a fee to a center. One would be motivated to do so in order to improve the control of access to broadcast transmissions.

Regarding claim 52, such a claim is obvious for the same reasons provided above in claim 35.

Allowable Subject Matter

Claims 30, 37, 47 and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 30, the closest prior art, Ushiki as modified by Cheung, does not explain an error detector which detects an error in reproduced information and generates an error signal when the quantity of the detected errors exceeds a predetermined value, wherein said charge calculator changes a charging condition in response to said error signal and said reproducing circuit reproduces said main information signal eyen when said error detector generates said error signal. Ushiki and Cheug teach that the charging signal is encoded with the main information signal (Cheung, col. 5, line 57, through col. 6, line 9). One of ordinary skill in the art at the time the invention was made would recognize only that an error in reception of the input would affect both the charging signal and the main information signal and, subsequently, change the charging condition. But the prior art does not explain that the charging signal would be effected by an error in the reproduced information, much less explain the generation of an error signal when the quantity of the detected errors exceeds a predetermined value. Therefore, for the reasons given above, such a claim would not be obvious.

Regarding claims 37 and 56, these are system versions of the claimed device discussed above (claim 30). Thus, for the reasons provided above, such a claim also would not have been obvious.

Regarding claim 47, this is another device version of the claimed device discussed above (claim 30), being dependent on claim 43 rather than claim 29. Thus, for the reasons provided above, such a claim also would not have been obvious.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lightfoot et al. (US 5,682,325) discloses a video distribution network that comprises a billing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Elmore whose telephone number is 571-272-4224. The examiner can normally be reached on M 10-8, T-Th 9-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JE

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